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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/315,882 09/30/94 BARRIE

S 604291

EXAMINER

RIZZU,N

12M2/1221
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ART UNIT

PAPER NUMBER

10

1202

DATE MAILED:

12/21/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on 9/11/95 This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 1-25 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-25 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

Art Unit 1202

The claims are 1-25.

All of the claims are again rejected as being obvious over Wicha et al. The reasons were given in the last office action and are incorporated herein by reference.

In the response dated September 11, 1995, applicants traverse the rejection and have submitted evidence via a Rule 132 Declaration. However, the evidence presented ~~for~~ ^{fails} to overcome the rejection for the following reasons. First, the absolute purity of the materials which is important, used has not been established on the record. Second, the evidence presented is not commensurate with the disclosure. Note the broad scope of claim 1. Third, if the test method used is a standard ^{one} ~~are~~ and reported in literature it should be made of record. Fourth, the closest prior art has not been evaluated which is required in view of ^{the} ~~Rulings~~ ^{of the Court} Event. See In re Burckel 201USPQ 67. Thus, the evidence when considered in its entirely fails to meet the thrust of the rejection and cannot be perceived as probative.

Claims 1-25 are rejected as failing to comply with 35 USC 112, 1st + 2nd paragraphs. The definition of "X" is such that "metes and bounds" have not been fixed. This is especially important here since applicants are urgency a highly selective invention requiring very specific compounds. It is clear that the invention if selective as is the case cannot be extrapolated beyond what has been shown to be operature. Additionally, it is

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Art Unit 1202

well known that the activity of a steroid is ~~different~~, if not
~~impossible~~ ^{difficult} to predict. See *in re Carleton* 202 USPQ165.

RIZZO/SG
December 14, 1995


NICHOLAS RIZZO
EXAMINER
ART UNIT 122